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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,787	10/05/2005	Hee Hyeok Hahm	123051-05016002	5698
22429 7590 01/25/2008 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314			EXAMINER TORRES, MARCOS L	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 01/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,787	Applicant(s) HAHM ET AL.	
	Examiner Marcos L. Torres	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 11 of copending Application No. 10/530,020. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claimed limitations are transparently found in the copending application with obvious wording variations. See

the following table of comparing claim 1 of pending Application and the claim 1 of
copending Application 10/530,020.

Co-pending Application 10/530,020	Application 10/523,787
1. A method of providing a predetermined sound as an RBT (RingBack Tone) in a communication network, said method comprising:	1. A method of providing a predetermined sound as an RBT (RingBack Tone) in a communication network, comprising:
an HLR (Home Location Register) furnishing a call-originating exchanger with information on whether or not an RBT is to be replaced for a called terminal through a response message to a location request message received from the call-originating exchanger that sends the location request message to the HLR when a call connection is requested by a caller to the called terminal;	an HLR (Home Location Register) furnishing a call-originating exchanger with information on whether an RBT is to be replaced or not and second information on a route to sound database through a response message to a location request message received from the call-originating exchanger that sends the location request message to the HLR when a call connection is requested by a caller to the called terminal;
the call-originating exchanger searching for a sound code assigned to the called terminal based on the information included	the conducted by the call-originating exchanger, requesting a first trunk connection to a call-terminating exchanger

in the response message; and	and a separate, second trunk connection to the database based on the response including the first and the second information while furnishing the sound database with third information identifying the called terminal; and
the call-originating exchanger providing the caller with a pre-stored RBT-replacing sound associated with the found sound code as an RBT while requesting a trunk connection to a call-terminating exchanger associated with the called terminal based on the response message.	the sound database, of selecting an RBT-replacing sound based on the third information, and providing the selected RBT-replacing sound to the caller through the second trunk connection and the call-originating.
	3. The method of claim 1, wherein the sound database searches for the selected RBT-replacing sound specified for the called terminal through communication with a storage controller operating based on the internet protocol.

As shown above, Application 10/530,020 and co-pending Application 10/523,787 both are directed to a method of providing a predetermined sound as an RBT (RingBack

Tone) in a communication network. The different between the two applications is that claim 1 of co-pending application 10/523,787 does not specifically teach the limitation "the call-originating exchanger searching for a sound code assigned to the called terminal based on the information included in the response message". However, claim 1 of co-pending Application 10/523,787 teaches "second information informing a route to sound providing means" and "furnishing the sound providing means with information identifying a called", and claim 3 of co-pending Application 10/523,787 teaches "the sound providing means searches for the selected RBT-replacing sound specified for the called" such that it obviously includes a searching step as recited in Application 10/530,020. Thus, it would have been obvious to one of ordinary skill in the art to recognize the claimed subject matter of Application 10/530,020 is not patentably distinct from the subject matter claimed in co-pending Application 10/523,787.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4 and 6-10 of U.S. Patent No. 7,242,757. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed limitations are transparently found in the copending application with obvious wording variations. See the following table of comparing claim 1 of pending Application and the claim 1 of U.S. Patent No. 7,242,757.

Application 10/523,787	US Patent No. 7,242,757
1. A method of providing a predetermined sound as an RBT (RingBack Tone) in a communication network, said method comprising:	1. A method of providing an arbitrary sound as an RBT (RingBack Tone) in a communication network, comprising:
an HLR (Home Location Register) furnishing a call-originating exchanger with information on whether an RBT is to be replaced or not and second information on a route to sound database through a response message to a location request message received from the call-originating exchanger that sends the location request message to the HLR when a call connection is requested by a caller to the called terminal;	a first step, conduct by an HLR (Home Location Register) furnishing a call-originating exchanger with information on whether or not an RBT is to be replaced for a terminal through a response to a location request message received from the call-originating exchanger that sends the location request message to the HLR when a call connection is requested to the called terminal;
the conducted by the call-originating exchanger, requesting a first trunk connection to a call-terminating exchanger and a separate, second trunk connection to the database based on the response	a second step, conducted by the call-originating exchanger, of requesting a trunk connection to a call-terminating exchanger based on the response, and further requesting another trunk

including the first and the second information while furnishing the sound database with third information identifying the called terminal; and	connection to a sound providing means based on the information with reference to preset routing information to the sound providing means while furnishing the sound providing means with information to identify the terminal;
the sound database, of selecting an RBT-replacing sound based on the third information, and providing the selected RBT-replacing sound to the caller through the second trunk connection and the call-originating.	a third step, conducted by the sound providing means, of selecting an RBT-replacing sound based on the called identifying information, and providing the selected RBT-replacing sound for a caller through the call-originating exchanger the trunk connection is made to.

As shown above, Application 10/523,787 and U.S. Patent No. 7,242,757 both are directed to a method of providing a predetermined sound as an RBT (RingBack Tone) in a communication network. The different between the two applications is that claim 1 of U.S. Patent No. 7,242,757 does not specifically teach the limitation "the call-originating exchanger searching for a sound code assigned to the called terminal based on the information included in the response message". However, claim 1 of U.S. Patent No. 7,242,757 teaches "second information informing a route to sound providing means" and "further requesting another trunk connection to a sound providing means based on

the information with reference to preset routing information to the sound providing means while furnishing the sound providing means with information to identify the terminal", which obviously including a searching step as recited in Application 10/530,020. Thus, it would have been obvious to one of ordinary skill in the art to recognize the claimed subject matter of Application 10/530,020 is not patentably distinct from the subject matter claimed in U.S. Patent No. 7,242,757. Furthermore, the claimed limitations recited in claim 3 are the same as claim 5 in Application 10/530,020, which is also similar to the claimed limitations as recited in claim 8 of U.S. Patent No. 7,242,757.

Conclusion

Any response to this Office Action should be mailed to:

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Or faxed to:

571-273-8300

for formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

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Randolph Building
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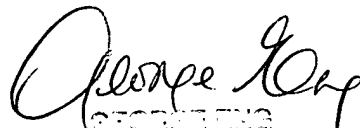
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L. Torres whose telephone number is 571-272-7926. The examiner can normally be reached on 8:00am-6:00 PM alt. Wednesday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcos L Torres
Examiner
Art Unit 2617

mlt


GEORGE ENG
SUPERVISORY EXAMINER